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09/994,973	11/27/2001	Dean M. Hildebrand	CA920000061US	2852

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EXAMINER

TRAN, NGHI V

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/994,973

Applicant(s)

HILDEBRAND, DEAN M.

Examiner

Nghi V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) 19-27 and 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 28-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/27/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Hitchcock et al. U.S. Patent # 6,345,278 (hereinafter Hitchcock).

3. With respect to claim 1, Hitchcock teaches a method of selectively displaying a markup language form element [38 i.e. "APPLY" button] on a Web page [fig.2 i.e. online applications] when an object is available to a Web server [16 i.e. server], the method comprising the steps of [see abstract and figs.13-15]:

- (a) associating [i.e. clicking on the element to access object] the markup language form element [38 i.e. "APPLY" button] with the object [col.4, Ins.23-47 and figs.2-3];
- (b) determining whether the object is available to the Web server [col.4, Ins.23-47 and figs.4&6A];
- (c) generating a markup language document that includes the markup language form element if the object is available to the Web server [figs.4-6; col.4, Ins.23-47; col.5, Ins.44-67; and col.6, Ins.1-11]; and
- (d) displaying the markup language form element on the Web page if the markup language document contains the markup language form element [figs.4, 6, 9, and 13; col.4, Ins.23-47].

4. With respect to claim 2, Hitchcock further teaches the markup language is HTML [col.4, Ins.23-32; col.5, Ins.44-67; and col.6, Ins.1-11].

5. With respect to claim 3, Hitchcock further teaches the markup language form element is a button [38 i.e. "APPLY" button].

6. With respect to claim 4, Hitchcock further teaches step (b) includes maintaining a record [i.e. stored] of whether the object is available to the Web server within a configuration file [col.21, Ins.14-39].

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7. With respect to claim 5, Hitchcock further teaches the configuration file is written in XML [col.21, Ins.14-39].

8. With respect to claim 6, Hitchcock further teaches the object is an application program [col.4, Ins.23-42 and col.21, Ins.14-39].

9. With respect to claim 7, Hitchcock further teaches step (c) further comprises the step of generating a markup language document that does not include the markup language form element if the object is not available to the Web server [col.18, Ins.59-67 and col.19, Ins.1-9].

The reference teaches the engine screens out (does not include) the term (element) already applied for when it return the applications. Therefore it states since the application is already applied and not available to apply again therefore screens out (does not include) it.

10. With respect to claim 8, Hitchcock further teaches step (c) further comprises the step of generating a markup language document that includes a disabled markup language form element if the object is not available to the Web server [col.18, Ins. 59-67 and col.19, Ins.1-9]

The reference teaches the engine screens out (does not include) the term (element) already applied for when it return the applications. Therefore it states since the application is already applied and not available to apply again therefore screening it

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out because if the application not available it is disable because one cannot access it anyway.

11. As per claim 9, Hitchcock teaches a computer program comprising means adapted to perform all the steps of claim 1 when said program is run on a networked computer. (Fig. 1 element 14,18,16,28) (Column 3 lines 55-67) (Column 4 lines 1-11, 24-42)

12. As per claim 10, Hitchcock teaches a computer program as claimed in claim 9 embodied on a computer readable medium. (Fig. 1 element 14,18,16,28) (Column 3 lines 55-67) (Column 4 lines 1-11, 24-42)

13. As per claims 11-18, they teach same limitations as claims 1-8 respectively, therefore rejected under same basis.

14. Per claims 19-27, they teach same limitations as claims 1-8 respectively, therefore rejected under same basis.

15. As per claims 28, Hitchcock teaches a computer system for selectively displaying a markup language form element on a Web page when an associated object is available to a Web server, said computer system comprising:

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-(a) a server for generating a markup language document (column 3 lines 65-67)(column 4 lines 1-11 lines 23-41), said server comprising:

(i) storage (Fig. 1 element 26) means for storing a value representing whether the object is available to the Web server (column 21 lines 13-29);

(ii) a first processing means coupled to said storage means for:

(A) determining whether the object is available to the Web server  
determining whether the object is available to the Web server  
(column 4 lines 23-47) (Fig. 4, 6A);

(B) generating a markup language document that includes the  
markup language form element if the object is available to the Web  
server (Fig. 4 element 54) (Fig. 6a,6b,6c,6d)(column 4 lines 23-47)(column 5 lines 44-67) (column 6 lines 1-11);

-(b) a communications network (Fig. 1 element 18) coupled to said server (Fig. 1 element 16); and

-(c) a second processing (Fig. 1 element 14,28) means coupled to said server through said communications network, said second processing means for reading and displaying the markup language document (column 3 lines 55-67)(column 4 lines 1-53).

16. As per claims 29-30, they teach same limitations as claims 2-3 respectively, therefore rejected under same basis.

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17. As per claims 31-32, they teach same limitations as claims 7-8 respectively, therefore rejected under same basis.

18. As per claim 33,35-36, they teach same limitations as claims 1-10, therefore rejected under same basis.

19. As per claim 34, Hitchcock teaches the product of claim 33, wherein said medium is a recordable data storage medium (Fig. 1 element 24,26).

20. As per claim 37, Hitchcock teaches the product of claim 36 wherein said network is the Internet (Fig. 1 element 18).

### ***Response to Arguments***

21. Applicant's arguments filed 05/02/2005 have been fully considered but they are not persuasive.

The Applicant argues, "Hitchcock does not disclose the step of "displaying the markup language form element on the Web page" after the step of "associating the markup language form element with the object." This argument is not commensurate with the scope of the claim because the Applicants does not claimed the sequence of the steps. Therefore, there is no limitation in the claim indicating the sequence of the steps such that the step of "displaying the markup language form element on the Web page"



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after the step of "associating the markup language form element with the object"  
(emphasis added).

### ***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi V Tran  
Patent Examiner  
Art Unit 2151

NT

  
**ZARNI MAUNG**  
**SUPERVISORY PATENT EXAMINER**